UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,452	12/22/1999	JOHN G. POSA	POS-01102/29	6162

7590 12/31/2001

JOHN G POSA ESQ
GIFFORD KRASS GROH SPRINKLE
ANDERSON & CITKOWSKI PC
280 N OLD WOODWARD AVENUE SUITE 400
BIRMINGHAM, MI 48009

EXAMINER
VO, HAI

ART UNIT	PAPER NUMBER
1771	5

DATE MAILED: 12/31/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

MFC

Office Action Summary	Application No. 09/470,452	Applicant(s) POSA ET AL.	
	Examiner Hai Vo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 1999* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *1-8* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Election/Restrictions

1. Applicant's election without traverse of Group II, claims 9-19 in Paper No. 4 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 9-10, 13, 15, 16, and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fusselman (US 5,707,482). Fusselman discloses a highlighting tape comprising a highlighting film and an adhesive (figure 1). Fusselman discloses the highlighting film is thin and flexible material (abstract). Fusselman is silent as to a newly formed edge that becomes visibly apparent when the tape is cut or torn. The Examiner wishes to point out that the phrase "visibly apparent" does not necessarily mean the same thing as "visually distinct from the non-edge area of the tape". However, since the highlighting

tape of Fusselman is structurally the same as the presently claimed tape, i.e., both tapes are composed of an adhesive layer and a backing layer, it is the examiner's position that the adhesive tape of Fusselman would inherently form the same new edge when the tape is cut or torn as the edge-indicating tape of the present invention. In addition, the edge formation as claimed would obviously have been provided. Note In re Best 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made under 35 USC 102.

With regard to claim 10, Fusselman teaches the backing and adhesive are transparent (column 1, lines 46-51).

With regard to claims 13 and 18, Fusselman teaches the backing film made of cellulose acetate (column 2, line 57).

5. Claims 9-11 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagai et al (US 5,693,394) or Sala et al (US 4,913,946). Nagai discloses a pressure-activated fluorescent marking tape comprising a carrier, fluorescent coloring agent layer and an adhesive layer (column 2, lines 11-15). Sala discloses a fluorescent adhesive tape comprising a fluorescent ink disposed between the support and adhesive (column 2, lines 30-34). There are no suggestions to combine the backing layer and the color layer into one layer in Nagai or Sala reference. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the backing layer and the color layer into one layer motivated by the desire to obtain the maximize the glowing of the fluorescent material in daylight because the fluorescent material is visible through

the transparent backing and is thereby effective to convert invisible rays of light into visible rays of light. Nagai and Sala are silent as to a newly formed edge becoming visibly apparent when the tape is cut or torn. The Examiner wishes to point out that the phrase "visibly apparent" does not necessarily mean the same thing as "visually distinct from the non-edge area of the tape". However, since the adhesive tape of Nagai or Sala is structurally the same as the presently claimed tape, i.e., both tapes are composed of an adhesive layer and a backing layer, it is the examiner's position that the adhesive tape of Nagai or Sala would inherently form the same new edge when the tape is cut or torn as the edge-indicating tape of the present invention. In addition, the edge formation as claimed would obviously have been provided. ***In re Best*** 195 USPQ at 433, footnote 4 (CCPA 1977).

With regard to claim 10, Nagai or Sala uses the same material for the backing and adhesive layers as the Applicant. It is the Examiner's position that the backing and adhesive layers of Nagai or Sala are also transparent.

With regard to claims 13 and 18, Nagai discloses polyvinyl used in the fluorescent coloring agent layer (column 2, line 34). Sala discloses the fluorescent ink comprising polyester such as polyethyl acetate (column 1, line 69).

With regard to claim 19, Nagai discloses the fluorescent material being a fluorescent dye (example 1). Sala discloses ink being yellow, orange, green or lilac (column 2, lines 36-38).

With regard to claims 14 and 17, since Nagai and Sala use the same fluorescent material as the Applicant, the fluorescent material of Nagai or Sala would inherently

exhibit the same optical density as claimed by the present invention. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have altered the amount of the fluorescent material since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. ***In re Aller***, 105 USPQ 233. It would have been obvious to the skilled artisian to have optimized the amount of the fluorescent material motivated by the desire to obtain a final product having a color that is pleasing to the eye and thus to improve its aesthetic appearance.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fusselman (US 5,707,482) or Nagai et al (US 5,693,394) or Sala et al (US 4,913,946), as applied to claim 9, and further in view of Argy et al (US 5,242,830). None of cited primary references disclose the microcapsules releasing the fluorescent material when the tape is cut or torn. Argy discloses a microcapsule that is intended to be broken during the impact and thus to release a fluorescent material which it enclose (abstract and column 3, lines 30-32). it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the microcapsules into the backing layer of the tape motivated by the desire to illuminate the backing layer with a radiation of a given wavelength to produce a photoluminescent reemission corresponding to those of the broken microcapsules.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00 (EAST).

   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (703) 308-1261. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

   Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
December 21, 2001

BLAINE COPENHEAVER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700